

REMARKS

Prior to this response, Claims 1-15 were pending in this application, with Claims 14 and 15 provisionally withdrawn from consideration. No claims are added or canceled. Hence, Claims 1-15 are presently pending in this application, with Claims 1-13 under examination and Claims 14 and 14 withdrawn from consideration.

In the Specification

The Office Action ("Action") objected to the Specification because the Abstract of the disclosure exceeded 150 words. A replacement Abstract that complies with the length requirement is submitted herein. Hence, the objection to the Specification is overcome and withdrawal of the objection is requested.

In the Claims

RESTRICTION/ELECTION

The Action restricted the application to one of the following inventions under 35 U.S.C. 121: (I) Claims 1-13; and (II) Claims 14 and 15. A provisional election of Group I, Claims 1-13, was made in a telephone conversation between the examiner and Applicant's representative, on April 5, 2004.

Election of Group I, Claims 1-13, is hereby affirmed.

REJECTIONS NOT BASED ON PRIOR ART

Rejection under 35 U.S.C. §112, first paragraph

The Action rejected Claims 1-13 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement because the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one

skilled in the art that the inventor had possession of the claimed invention at the time the application was filed. This rejection is traversed.

Claim 1

Claim 1 was rejected on the basis that the specification allegedly does not adequately disclose an apparatus configuration that does not include the frame 003. This allegation is not true and a prima facie case of inadequate written description was not established.

As a preliminary matter, it is noted that the written description requirement requires the specification to describe an embodiment that satisfies all of the limitations of the claim. It does **not** require a claim to include all of the features of a described embodiment. In the present case, the embodiment illustrated in FIG. 1 satisfies all of the limitations of Claim 1. Therefore, the specification satisfies the written description requirement relative to Claim 1.

The current written restriction rejection seems to be based on the proposition that “a claim that fails to recite a particular feature is treated as if the claim affirmatively recited the absence of the feature”. However, such a proposition is absurd. For example, if a claim to a bicycle does not mention fenders, the claim is not treated (for the purpose of 35 USC 112) as if the claim affirmatively recited the limitation “wherein said bicycle does not have fenders.” Thus, the failure to mention fenders in the claim does not require a written description of a fenderless bicycle. Similarly, the failure to recite the feature of frame 003 does not require a written description of an embodiment that does not include a frame. MPEP 904.01(a) recognizes that “Substantially, **every claim includes within its breadth or scope one or more variant embodiments that are not disclosed in the application...**”

Further, there is no requirement that the **claims** provide the written description of the invention under 35 U.S.C. §112, first paragraph. The Court of Appeals for the Federal Circuit (“Federal Circuit”) has noted two measures impermissible in law: (1) requiring a claim

“describe” the invention, which is the role of the disclosure portion of the specification, not the claims; and (2) application of the “full, clear, concise, and exact” requirement of the first paragraph of §112 to the claim, **“when that paragraph applies only to the disclosure portion of the specification, not the claims.”** Orthokinetics Inc. v. Safety Travel Chairs Inc., 806 F.2s 1565, 1 USPQ 2d 1081 (Fed. Cir. 1986); emphasis added.

Furthermore, claims can constitute an adequate written description of the invention. The predecessor court to the Federal Circuit (C.C.P.A.) has noted that it considers **“the original claim in itself adequate ‘written description’** of the claimed invention” and “[i]t was equally a ‘written description’ whether located among the original claims or in the descriptive part of the specification.” In re Gardner, 480 F.2d 879, 178 USPQ 149 (C.C.P.A. 1973).

Next, FIG. 1 is described as an exploded view of a safety tool, **“in accordance with an embodiment of the invention.”** Thus, the configuration described in reference to FIG. 1 is not the only embodiment of the invention that is described in the application. Rather, FIG. 1 illustrates only one of many embodiments of the invention described in the application. Furthermore, paragraph [0034] specifically states that **“in one embodiment,** the magnets 001 and the metal strip 002 are **encased by a frame 003.”** Nowhere in the specification does it state that the frame 003 is required in each and every embodiment of the invention. One skilled in the art would recognize and appreciate that the frame is not required in every implementation of the invention, especially in light of paragraph [0037], which describes an embodiment in which the magnets 001 are sewn into pouches of the outer sheath 004, rather than coupled to the frame 003.

Next, paragraph [0050] of the application specifically states that “[t]he specification and drawings are, accordingly, to be regarded in an illustrative rather than a restrictive sense.” Thus, Applicant is not limited to claiming a single embodiment that is described in the

application, such as an embodiment that includes all the elements illustrated in FIG. 1. Rather, the invention may be claimed by reciting any novel combination of features, so long as at least one disclosed embodiment includes the recited combination of features. The specification does not need to disclose embodiments that are missing those features that are not expressly recited. As the Court of Appeals for the Federal Circuit has proclaimed, “[t]he invention is, for purposes of the ‘written description’ inquiry, whatever is now claimed.” Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 19 USPQ 2d 1111 (Fed. Cir. 1991).

The Action further alleges that the “specification does not disclose the function of the magnets on the proximal end of the outer sheath” (page 4). This allegation is not true. For example, paragraph [0031] states that one or more multi-pole magnets 001 **“allow the tool 100 to fasten to the inner surface of switchgear...”**

For all of the foregoing reasons, the rejection of Claim 1 under 35 U.S.C. §112, first paragraph, is not a valid rejection. Therefore, withdrawal of the rejection of Claim 1 under 35 U.S.C. §112, first paragraph is respectfully requested.

Claim 2

The Action alleges that “the disclosure does not state that the magnets on the proximal end of the outer sheath are capable of securing the frame and the sheath to the housing.” This allegation is not true. As previously noted as an example, paragraph [0031] states that one or more multi-pole magnets 001 **“allow the tool 100 to fasten to the inner surface of switchgear...”**

If, perhaps, the Action was meant to state that *Claim 2* does not state that the magnets on the proximal end of the outer sheath are capable of securing the frame and the sheath to the housing, it is noted that Claim 2 is not a “means plus function” claim as defined in and governed by 35 U.S.C. §112, sixth paragraph, so the foregoing statement would be irrelevant to

Claim 2. Furthermore, the language referred to in the Action is not even recited in Claim 2 so it is unclear why Claim 2 would be rejected based on an alleged insufficient disclosure with respect to such language.

There is no legal basis for requiring apparatus claims to recite a function for the apparatus, nor for requiring apparatus claims to recite a function for each element of the apparatus. Even if there were some legal basis to substantiate a requirement that the claim state what is suggested in the Action, as noted above, paragraph [0031] states that one or more multipole magnets 001 “allow the tool 100 to fasten to the inner surface of switchgear...”

For all of the foregoing reasons, the rejection of Claim 2 under 35 U.S.C. §112, first paragraph, is not a valid rejection. Therefore, withdrawal of the rejection of Claim 2 under 35 U.S.C. §112, first paragraph is requested.

Claim 5

The Action alleges that “the disclosure does not state that the device has two sets of magnets on the outer sheath and one or more first magnets coupled near the proximal portion of the frame.” This allegation is not true and it is unclear exactly what the Action is referring to in referring to “two sets of magnets on the outer sheath”.

However, Claim 1, from which Claim 5 indirectly depends, clearly recites (1) **one or more first magnets coupled near the proximal end of the outer sheath**, and (2) **one or more second magnets** disposed within and near the distal end of the outer sheath. With reference to FIG. 1, (1) magnets 001 are examples of “one or more first magnets” and are described in paragraphs [0031]-[0033] of the application; and (2) magnet 005 is an example of “one or more second magnets” and is described in paragraphs [0038]-[0041]. Furthermore, recall that paragraph [0037] describes an embodiment in which the **magnets 001 are sewn into pouches of the outer sheath 004**.

The embodiment recited in Claim 5 is configured similarly to the embodiment illustrated in FIG. 1, where the **one or more first magnets are coupled near the proximal portion of the frame**, as recited in Claim 2 from which Claim 5 indirectly depends. For example, magnets 001 may be inset into first and second recessed portions of frame 003, as depicted in FIG. 1, described in paragraph [0032] and recited in Claim 5.

For all of the foregoing reasons, the rejection of Claim 5 under 35 U.S.C. §112, first paragraph, is not a valid rejection. Therefore, withdrawal of the rejection of Claim 5 under 35 U.S.C. §112, first paragraph is requested.

Claims 3, 4 and 6-13

The remaining claims under examination, Claims 3, 4 and 6-13, depend directly or indirectly from Claim 1. Therefore, the §112, first paragraph, rejection of these claims is also invalid, for at least the reasons discussed above in reference to Claim 1. Withdrawal of the rejection of Claims 3, 4 and 6-13 under 35 U.S.C. §112, first paragraph, is requested.

Rejection under 35 U.S.C. §112, second paragraph

The Action rejected Claims 1-13 under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. This rejection is traversed.

Claim 1

Claim 1 was rejected on the basis that the specification does not adequately disclose an apparatus configuration that does not include the frame 003. However, as explained above, no section of 35 USC 112 requires the disclosure of **embodiments that are missing features that are not recited** in a claim. Thus, a prima facie case of indefiniteness was not established.

The Action alleges that the “frame is required to perform the claimed function” (page 4). First, there is no function recited in the body of Claim 1 so it is not entirely clear as to what

“claimed function” the Action refers. However, the preamble does recite an apparatus **for containing debris**. As noted above, the frame is not a required element for every embodiment disclosed in the application. Hence, if the “claimed function” is to “contain debris,” the frame is not required to perform such a function. Recall that paragraph [0037] describes an embodiment in which the **magnets 001 are sewn into pouches of the outer sheath 004**, which could still be attached to switchgear, for example, in order to contain debris from a drilling operation on the switchgear. Furthermore, since the inclusion of the frame 003 is described in paragraph [0034] in accordance with **one embodiment**, the application clearly discloses that the use of the frame is not required and, therefore, that an embodiment of the invention does not include the frame 003.

Still further, the frame can serve multiple functions, in addition to housing the one or more first magnets, as in Claim 5. For example, the frame, if used, (1) can provide a fixed opening to enclose the “work area” of the equipment being worked on (e.g., switchgear), and (2) can provides support structure for the outer sheath and/or inner bag.

The Action further alleges that the “specification does not disclose the function of the magnets on the proximal end of the outer sheath” (page 4-5). As previously noted, paragraph [0031] of the application states that one or more multi-pole magnets 001 (i.e., one or more first magnets) **“allow the tool 100 to fasten to the inner surface of switchgear...”**

For all of the foregoing reasons, the rejection of Claim 1 under 35 U.S.C. §112, second paragraph, is not a valid rejection. Therefore, withdrawal of the rejection of Claim 1 under 35 U.S.C. §112, second paragraph, is respectfully requested.

Claim 2

The Action alleges, as with the §112 first paragraph rejection, that “the disclosure does not state that the magnets on the proximal end of the outer sheath are capable of securing the

frame and the sheath to the housing.” The remarks presented above in reference to the §112 first paragraph rejection of Claim 2 apply equally to the §112 second paragraph rejection of this Claim. Therefore, withdrawal of the rejection of Claim 2 under 35 U.S.C. §112, second paragraph is requested.

Claims 4 and 5

The Action rejected Claims 4 and 5 for allegedly lacking antecedent basis. Claim 4 is amended herein to refer to “a respective recess” instead of “the respective recess”. Therefore, this rejection of Claim 4 is overcome, and withdrawal of the rejection of Claim 4 based on improper antecedent basis is kindly requested.

Claim 5 introduces “a first recess” and “a second recess” so there is no problem with antecedent basis in this claim as filed. Withdrawal of the rejection of Claim 5 based on improper antecedent basis is requested. Further, with respect to Claim 5, the Action alleges, as with the §112 first paragraph rejection, that “the disclosure does not state that the device has two sets of magnets on the outer sheath and one or more first magnets coupled near the proximal portion of the frame.” The remarks presented above in reference to the §112, first paragraph, rejection of Claim 5 apply equally to the §112 second paragraph rejection of this claim. Therefore, withdrawal of the rejection of Claim 5 under 35 U.S.C. §112, second paragraph, is requested.

Claims 3 and 6-13

The remaining claims under examination, Claims 3 and 6-13, depend directly or indirectly from Claim 1. Therefore, the §112, second paragraph, rejection of these claims is also invalid, for at least the reasons discussed above in reference to Claim 1. Withdrawal of the rejection of Claims 3 and 6-13 under 35 U.S.C. §112, second paragraph, is requested.

REJECTION BASED ON PRIOR ART

Rejection under 35 U.S.C. §102(b)

The Action rejected Claims 1, 8 and 10 under 35 U.S.C. §102(b) as allegedly anticipated by *Alfero-Kuronya* (“*Alfero-Kuronya*”; U.S. Patent No. 6,505,967). This rejection is traversed.

As a preliminary matter, it is noted that the present application claims a priority filing date of **August 28, 2002** based on U.S. Provisional Patent Application No. 60/406,369. Therefore, *Alfero-Kuronya*, which issued on January 14, 2003 does not qualify as a prior art reference under 35 U.S.C. §102(b) because the invention disclosed was not patented more than one year prior to the date of the application. In fact, the invention disclosed in *Alfero-Kuronya* was patented after the effective date of the application.

However, for purposes of expediting the allowance of the present application, the reasons that the claims are allowable over *Alfero-Kuronya* shall be set forth hereafter, even though *Alfero-Kuronya* cannot be used as a basis for the current rejection.

Claim 1

For a proper anticipation rejection, a reference must show each and every feature of a claim in the same combination as claimed. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983). *Alfero-Kuronya* does not disclose, explicitly or implicitly, all of the features recited in Claim 1.

Generally, *Alfero-Kuronya* does not disclose (1) **a removable inner bag disposed within an outer sheath**, and (2) **one or more magnets disposed within the outer sheath and near the distal end of the outer sheath**. Hence, a prima facie case of anticipation is not established because *Alfero-Kuronya* does not disclose each and every feature of Claim 1 and, therefore, cannot anticipate Claim 1.

Addressing the stated rejection more specifically, element 30 of *Alfero-Kuronya* is not a sheath, as alleged in the Action. Element 30 is described as “a drill, punch or cutting area 30” (col. 5, line 7), “a drill, cut or punch opening 30” (col. 5, lines 28 and 29) and “an opening 30” (col. 5, line 52). Clearly, an “area” or “opening” is not a sheath. In addition, the magnets 18 of *Alfero-Kuronya* are not near both the proximal and the distal end of collection bag 22 (which could be considered a sheath). By contrast, all of magnets 18 are near a single end of collection bag 22, i.e., the end at which top planar support member 14 and bottom planar support member 16 are attached to the collection bag 22.

For all of the foregoing reasons, *Alfero-Kuronya* does not anticipate Claim 1. Consequently, Claim 1 is patentable over *Alfero-Kuronya* and withdrawal of the rejection of Claim 1 under 35 U.S.C. §102 is respectfully requested.

Claim 8

Claim 8 depends directly from Claim 1. Hence, for a valid anticipation rejection of Claim 8, a prior art reference must disclose and teach each and every element of Claim 8 and Claim 1. The Action alleges that element 16 of *Alfero-Kuronya* anticipates the magnet housing that is recited in Claim 8. However, element 16 is part of an embodiment illustrated in FIGS. 5 and 6 that is an alternative (see col. 5, line 25) to the embodiments illustrated in FIGS. 1-4, on which the Action relied for rejection of Claim 1. Hence, *Alfero-Kuronya* does not disclose and does not anticipate an apparatus that includes all of the features of Claim 8, including the features of Claim 1, in a single apparatus. Planar member 16 does not function as a magnet housing in the configuration illustrated in FIGS. 3 and 4. Rather, planar support member 16 is used to “securely retain collection bag 22” and for “creating a square or rectangular opening 32 for the particles to fall through” (col. 5, lines 13-17).

For the foregoing additional reasons, Claim 8 is patentable over *Alfero-Kuronya*.

Withdrawal of the rejection of Claim 8 under 35 U.S.C. §102 is requested.

Claim 10

Claim 10 depends from Claim 1 and, therefore, is patentable over *Alfero-Kuronya* for the same reasons as Claim 1. Withdrawal of the rejection of Claim 10 under 35 U.S.C. §102 is requested.

Rejection under 35 U.S.C. §103(a)

The Action rejected Claims 1, 8, 9, 10 and 12 under 35 U.S.C. §103(a) as allegedly unpatentable over Yoshikawa (“*Yoshikawa*”; U.S. Patent No. 5,367,278) in view of Anderson et al. (“*Anderson*”; U.S. Patent No. 5,871,114). This rejection is traversed.

Claim 1

Yoshikawa does not disclose or suggest one or more second magnets **disposed within** an outer sheath. By contrast, *Yoshikawa* discloses “3 units of said mounting frame 2 in strategical positions on its [basket 1] rear surface 1a (FIG. 1)” (col. 2, lines 45-48). There is no teaching or suggestion of, and no motivation to one skilled in the art to, dispose a magnet within the basket of *Yoshikawa*. It is highly likely that disposing a magnet within the basket of *Yoshikawa* would be detrimental to the stated objectives of the “magnetic holding structure” of *Yoshikawa*, i.e., the ability to “hold” items would be affected negatively by interference with a magnet disposed on the inside of the basket.

For the foregoing reasons, a combination of *Yoshikawa* and *Anderson* does not make obvious Claim 1 because such a combination would not include each and every feature recited in Claim 1. Therefore, Claim 1 is patentable over these cited references. Withdrawal of the rejection of Claim 1 under 35 U.S.C. §103, based on *Yoshikawa* and *Anderson*, is kindly requested.

Claims 8-10 and 12

The remaining claims under this rejection, Claims 8-10 and 12, depend directly or indirectly from Claim 1. Therefore, Claims 8-10 and 12 are patentable over *Yoshikawa* and *Anderson* for at least the foregoing reasons discussed in reference to Claim 1. Furthermore, each of Claims 8-10 and 12 includes at least one additional feature that is not disclosed or suggested in *Yoshikawa* or *Anderson*, which also make it patentable over the cited references. However, since a fundamental distinction between Claim 1 and the cited references is already shown above, no additional remarks are presented with respect to Claims 8-10 and 12 at this time. Withdrawal of the rejection of Claims 8-10 and 12 under 35 U.S.C. §103, based on *Yoshikawa* and *Anderson*, is requested.

The Action rejected Claims 1, 12 and 13 under 35 U.S.C. §103(a) as allegedly unpatentable over Sutton (“*Sutton*”; U.S. Patent No. 6,179,025). This rejection is traversed.

Claim 1

Sutton does not disclose or suggest an **apparatus for containing debris**, in which **one or more second magnets** is disposed within and near the distal end of the outer sheath **to attract metallic debris that enters a removable inner bag**. By contrast, *Sutton* discloses a carry bag with a pouch insert, particularly handbags, diaper bags, briefcases, knapsacks, and tote bags (col. 1, lines 19-22), which can be used to store personal items (col. 2, line 67). The magnetic snap fastener portion 13 functions to couple inner pouch 11 to exterior cover 12. *Sutton* does not disclose, suggest or motivate an apparatus for containing debris, which uses a magnet to help contain and secure within an inner bag any magnetic debris that may enter the inner bag, for example, when being used to contain metal filings generated by drilling into a switchgear enclosure.

In addition, it is improbable that one skilled in the art of electrical/electronic safety tools would look to the art of carrying bags for a suggestion or motivation with respect to developing **a safety tool for containing debris from electrical work**. In a case in which a combination of two references (the first relating to a metal hose clamp without a hook, and the second relating to a plastic hook and eye fastener used in garments) were used in support of an obviousness rejection of a claim that involved an improvement in a metal hose clamp having a preassembly hook, the Federal Circuit stated that “[t]he combination of elements from non-analogous sources, in a manner that reconstructs the applicant’s invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination.” *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992). Therefore, *In re Oetiker* stands for the proposition that it is not proper to combine non-analogous prior art. One skilled in the art of electrical safety tools would not find a motivation or suggestion to turn to the *Sutton* reference to develop that which is recited in Claim 1 because the *Sutton* reference is non-analogous art. Consequently, one skilled in the art of electrical safety tools would not find obvious the invention recited in Claim 1 based on the *Sutton* reference.

For all the foregoing reasons, a prima facie case of obviousness is not established for Claim 1 based on *Sutton*. Therefore, Claim 1 is patentable over *Sutton* and withdrawal of the rejection of Claim 1 under 35 U.S.C. §103, based on *Sutton*, is requested.

Claims 12 and 13

The remaining claims under this rejection, Claims 12 and 13, depend directly or indirectly from Claim 1. Therefore, Claims 12 and 13 are patentable over *Sutton* for at least the foregoing reasons discussed in reference to Claim 1. Furthermore, each of Claims 12 and 13

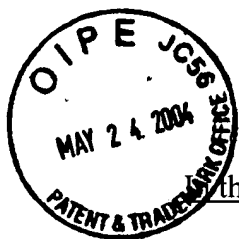
includes at least one additional feature that is not disclosed or suggested in *Sutton*, which also make it patentable over the cited references. However, since a fundamental distinction between Claim 1 and the cited references is already shown above, no additional remarks are presented with respect to Claims 12 and 13 at this time. Withdrawal of the rejection of Claims 12 and 13 under 35 U.S.C. §103, based on *Sutton*, is requested.

The Action rejected Claims 2 and 3 under 35 U.S.C. §103(a) as allegedly unpatentable over *Sutton* in view of *Koret* (“*Koret*”; U.S. Patent No. 2,875,802). This rejection is traversed.

Claim 2

As Claim 2 depends from Claim 1, the foregoing remarks presented in reference to Claim 1 and the *Sutton* reference are equally applicable to Claim 2. That is, *Sutton* (1) does not disclose or suggest an **apparatus for containing debris**, in which **one or more second magnets** is disposed within and near the distal end of the outer sheath **to attract metallic debris that enters a removable inner bag**; and (2) one skilled in the art of electrical/electronic safety tools would not look to the art of carrying bags for a suggestion or motivation with respect to developing a **safety tool for containing debris from electrical work**. The same rationale applies to *Koret*, which also discloses a handbag, purse, or the like, but makes no mention of an apparatus for containing magnetic debris. Hence, one skilled in the art of electrical safety tools would not be motivated to look to the *Sutton* and *Koret* references for teachings about electrical safety tools and, therefore, would not find obvious the invention recited in Claim 2 based on these references.

Withdrawal of the rejection of Claim 2 under 35 U.S.C. §103, based on *Sutton* and *Koret*, is requested. Because Claim 3 depends from Claim 2, Claim 3 is patentable over *Sutton* and *Koret* for at least the foregoing reasons discussed in reference to Claim 2.



the Drawings

Four sheets of drawings (FIGS. 1-4) in compliance with 37 CFR 1.84 are submitted with the label "Replacement Sheet" as an attachment herewith. These sheets replace the corresponding original sheets. No substantive changes have been made to the figures, rather, matters of formality in compliance with 37 CFR 1.84 have been met. Hence, no new matter is introduced into the application by way of the amendments to the drawings.

CONCLUSION

For at least the reasons indicated above, Applicants submit that all of the pending claims currently under consideration (1-13) present patentable subject matter over the references of record, and are in condition for allowance. Therefore, Applicants respectfully request that a timely Notice of Allowance be issued in this case. If the Examiner has questions regarding this case, the Examiner is invited to contact Applicant's undersigned representative.

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortages in fees due in connection with the filing of this paper, including extension of time fees, or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

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on 5/20/04 by David Palermo

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Attorney Docket No. 60081-0011